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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,825	08/06/2003	Akira Nagashima	03500 016040.1	7347
5514	7590	08/20/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			SHAH, MANISH S	
		ART UNIT		PAPER NUMBER
				2853

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/634,825	NAGASHIMA ET AL.	
	Examiner	Art Unit	
	Manish S. Shah	2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 July 2004.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 and 20-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 and 20-49 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. 10/021,091.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 & 38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,676,254 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed in the US Patent and is covered by the US Patent, since the US patent and the application are claiming common subject matter, as follows as shown in Table: 1 below.

**TABLE: 1**

# US 6676254 B2 CLAIMS	# 10/634,825 CLAIMS
<p>1. A recording method comprising a step of providing an ink from a recording head to a recording medium through a gap provided between the recording head and the recording medium, the ink being supplied to the recording head from an ink tank comprising an ink contact member and the ink contacting the ink contact member, wherein the ink comprises</p> <ul style="list-style-type: none"> <li>(i) a fluorescent coloring material;</li> <li>(ii) a nonionic surfactant;</li> <li>(iii) a compound which is not compatible with (ii) and; which has a solubility parameter of not less than 15; and</li> <li>(iv) a liquid medium for dissolving or dispersing (i), (ii) and (iii), and</li> </ul> <p>wherein the ink contact member comprises at least one compound selected from the group consisting of polyacetate and polyolefin.</p>	<p>1. A recording method comprising a step of providing an ink from a recording head to a recording medium through a gap provided between the recording head and the recording medium, the ink being supplied to the recording head from an ink tank comprising an ink contact member and the ink contacting the ink contact member, wherein the ink comprises</p> <ul style="list-style-type: none"> <li>(i) a fluorescent coloring material;</li> <li>(ii) a nonionic surfactant;</li> <li>(iii) a compound which is not compatible with (ii); and</li> <li>(iv) a liquid medium for dissolving or dispersing (i), (ii) and (iii), and</li> </ul> <p>wherein the ink contact member comprises at least one compound selected from the group consisting of polyacetate and polyolefin.</p> <p>38. An ink cartridge comprising an aqueous ink and ink contact member, wherein the ink comprises</p> <ul style="list-style-type: none"> <li>(i) a fluorescent coloring material;</li> <li>(ii) a nonionic surfactant;</li> <li>(iii) a compound which is not compatible with (ii); and</li> <li>(iv) a liquid medium for dissolving or dispersing (i), (ii) and (iii), and</li> </ul> <p>wherein the ink contact member comprises at least one compound selected from the group consisting of polyacetate and polyolefin.</p>

With respect to claim 1, the pending application claiming the recording method steps, which is almost same as of US patent.

However, the pending application claimed a compound, which is not compatible with (ii), which is broader limitation than the US Patent, so this limitation still can read by the US Patent claim.

It was obvious to one of ordinary skill in the art at the time of invention was made to use the ink composition of the US Patent in to the recording method of pending application to get the printed image.

With respect to claim 38, the pending application claiming the ink cartridge including the ink composition, which is almost same ink as US Patent.

However, the US Patent did not claim an ink cartridge it is obvious to one of ordinary skill in the art that to store the ink, recording apparatus need in cartridge of pending application.

It was obvious to one of ordinary skill in the art at the time of invention was made to use the ink composition taught in the US Patent in to the ink cartridge of pending application to store the ink, and which is very easy for handling.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

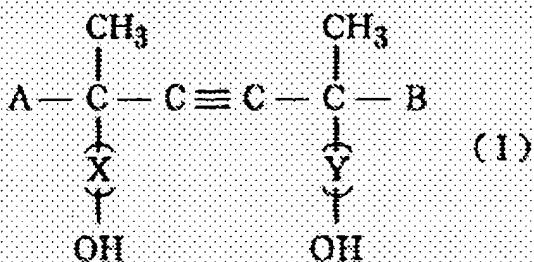
3. Claims 1-18 & 20-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Nagashima et al. (# US 6676734).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C.

102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Nagashima et al. discloses a recording method comprising a step of providing an ink from a recording head to a recording medium through a gap provided between the recording head and the recording medium, the ink being supplied to the recording head from an ink tank comprising an ink contact member and the ink contacting the ink contact member (column: 38, line: 49-68; column: 39, line: 1-36), wherein the ink comprises (i) a fluorescent coloring material, which is an azo dye (column: 11, line: 1-25) and the ink contains ammonium ions and alkali metal ions, and at least one selected from urea and derivatives thereof, which includes alkyl derivatives of urea and ethylene oxide adducts of urea and propylene oxide adducts of urea; and the surface tension of the ink is not more than 40mN/m (dyne/cm) (column: 26, line: 10-25) and pH is not more than 8; (ii) a nonionic surfactant; (iii) a compound which is not compatible with (ii) and has the solubility parameter not less than 15 (column: 8, line: 25-35), which is selected from ethylene oxide, sugar alcohol (column: 8, line: 40-50); and (iv) a liquid medium for dissolving or dispersing (i), (ii) and (iii) (see Abstract; column: 2, line: 50-65), and wherein the ink contact member comprises at least one compound selected from the group consisting of poly acetate and polyolefin (column: 29, line: 20-30). They also disclose that the contact member is an ink-container with an ink holding member (figure: 1-3). They also discloses

the step includes the sub-steps of: ejecting ink droplets from an orifice in response to recording signals with ink-jet method, and conducting recording on the recording medium (column: 38, line: 49-68), which is performed by applying thermal energy to the ink (column: 27, line: 30-35). They also disclose that the fluorescent coloring material is water-soluble or hydrophilic (column: 11, line: 1-7), wherein the concentration of the fluorescent coloring material in the ink is equal to or exceeds the concentration thereof exhibiting the maximum fluorescence intensity, and wherein the concentration of the fluorescent coloring material in the ink is not more than 1.5% by mass based on total mass of the ink (column: 14, line: 55-65), wherein the fluorescent coloring material is a fluorescent dye (column: 11, line: 5-23). They also discloses that the nonionic surfactant is a liquid at room temperature and has an HLB of not more than 13 (column: 9, line: 11-20) and the concentration of the nonionic surfactant in the ink is a value causing no phase separation in the ink and the concentration of the nonionic surfactant in the ink is that does not cause phase separation of the nonionic surfactant even when the ink does not contain the fluorescent coloring material, wherein the concentration of the nonionic surfactant is contained in an amount not more than 1.0% by mass based on total weight of the ink (column: 9, line: 25-50). They also disclose that the nonionic surfactant has a structure represented by the following formula (column: 9, line: 50-65).



(wherein A and B are independently  $C_nH_{2n+1}$  (n being an integer of 1 to 10), and X and Y are independently a ring-opened ethylene oxide unit and/or a ring-opened propylene oxide unit.)

4. Claims 38-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Nagashima et al. (# US 6676734).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Nagashima et al. discloses an inkjet recording apparatus including an ink cartridge including an aqueous ink and ink contact member (figure: 4, 13 & 28; column: 38, line: 49-68; column: 39, line: 1-36), wherein the ink includes (i) a fluorescent coloring material, which is an azo dye (column: 11, line: 1-25) (ii) a nonionic surfactant; (iii) a compound which is not compatible with (ii) and has the

solubility parameter not less than 15 (column: 8, line: 25-35), which is selected from ethylene oxide, sugar alcohol (column: 8, line: 40-50); and (iv) a liquid medium for dissolving or dispersing (i), (ii) and (iii) (see Abstract; column: 2, line: 50-65), and wherein the ink contact member comprises at least one compound selected from the group consisting of poly acetate and polyolefin (column: 29, line: 20-30). They also disclose that the contact member is an ink-container with an ink-holding member (figure: 1-3), wherein ink-holding member is porous, contact with the ink container, with multi layer structure (figure: 5-6, 13).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manish S. Shah  
Examiner  
Art Unit 2853



MSS

8/18/04